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Michael Kende

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL KENDE,
ROBERTS CHRISTIAN MACDONALD,
and JAMES G. GATTO

Appeal 2009-006124
Application 09/997,273
Technology Center 3600

Decided: March 26, 2010

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JEFFREY FREDMAN, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Michael Kende et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-26. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

THE INVENTION

This invention is a method and system for determining preferred billing rate plans for individual users based on one or more of a user's personal preferences, prior usage patterns and service provider rate plans. Specification 2:6-12.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer implemented multi-factor rate analysis system for analyzing service provider rate plan information, the system comprising:
 - a user module for accessing user information including a user's prior usage information and the user's preferences;
 - a service provider database for storing service provider information wherein service provider information comprises rate plan

¹ Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Jul. 2, 2007) and the Examiner's Answer ("Answer," mailed Oct. 1, 2008).

information associated with one or more service providers; and

a multi-factor rate analysis engine module for analyzing on a per user basis user information and service provider information to generate one or more savings suggestions based on the rate plan information, the user's prior usage information and at least one user preference.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Roberts

US 6,885,997 B1

Apr. 26, 2005

The following rejection is before us for review:

1. Claims 1-26 are rejected under 35 U.S.C. §102(e) as being anticipated by Roberts.

ISSUE

The issue is whether claims 1-26 are anticipated under 35 U.S.C. § 102(e) by Roberts. Specifically, the major issue is whether Roberts describes a multi-factor rate analysis engine module for analyzing on a per user basis user information and service provider information to generate one or more savings suggestions based on the rate plan information, the user's prior usage information and at least one user preference.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v.*

Quigg, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Roberts describes a system and method for comparing rate plans, such as those in the telecommunications industry. Col. 1, lines 7-10.
2. Roberts describes a computer 10 which comprises a reduction device 10a, a comparison device 10b, and a reporting device 10c and which is used to perform an analysis to generate a report 60. Roberts, Col. 4, lines 64-col. 5, line 30. *See also* Fig. 5, item 416.
3. Roberts describes inputting rate plan characteristic information and client usage information into a database 100. Col. 7, ll. 38-60 and Col. 7, l. 66 – col. 8, l. 4.
4. Roberts describes the database 100 including characteristics about usage, which includes associated time in hours, minutes, or seconds. Col. 7, l. 66 – col. 8, ll. 5.
5. Roberts describes database 100 being maintained on memory 12 (col. 5, ll. 35-41) and describes that memory 12 may be separate from computer 10 (col. 4, ll. 12-20).
6. Roberts states: “Data concerning clients 16 may be entered via an interactive client information form, by processing scanned data such as optical recognition methods, by batch, or a combination thereof.” Col. 7, ll. 51-54.
7. Roberts describes that this data may be phone bill data, including Internet charges. Col. 7, ll. 54-60.
8. Roberts states: “Accordingly, before an analysis is done, a proposed service provider plan must be selected.” Col. 8, ll. 64-65.

9. Roberts describes generating a report that includes current details about a current service provider, proposed details about a proposed service provider, comparison details on savings as well as labels and notes. Col. 9, ll. 12-18.
10. Roberts describes the proposed plan on the report may includes Internet serves as well as telephone services. *See* col. 9, ll. 22-26.
11. Roberts describes that the notes on the report may includes text describing special conditions or features of a particular plan and minimum volume requirements. Col. 9, ll. 25-28.
12. Roberts describes that the report can optionally include label information or that the information can be suppressed by unchecking a check box on an interactive form or setting a reporting option. Col. 9, ll. 29-38.
13. Roberts states that the report “can be created as paper printouts, visual displays, binary data encapsulated in binary files such as on magnetic media or optical media.” Col. 5, ll. 25-30.
14. Roberts states “once report 60 is created, client 16 may choose to switch 602 service providers 17 to obtain the savings outlined in report 60.” Col. 9, ll. 49-52.
15. Roberts describes an agent having a client fill out paperwork for the switch and suggests that some of the information for the paperwork can be automatically retrieved from the database. Col. 9, ll. 52-57.
16. Roberts describes the database having at least one order tracking table 241. Col. 7, ll. 33-37.

17. Roberts describes the system creating and tracking an order to switch providers. Col. 9, ll. 51-67 and Fig. 8.
18. Roberts states: “Clients 16 and their orders may thus be associated with an agent 15, allowing that agent 15 to obtain credit from a service provider 17 for the order.” Col. 9, ll. 64-66.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

The rejection of claims 1-26 under §102(e) as being anticipated by Roberts.

The Appellants argue the claims in the following groups. Br. 15-22. We note that each group contains an apparatus claim and a corresponding method claim, except for claims 10, 13, 23, and 26. As the Appellants have done (*See* Br. 15-22), we will address the apparatus claims and the method claim will stand or fall with the apparatus claims, except for claims 10, 13, 23, and 26. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

Claims 1 and 14

The Appellants argue that the passages of Roberts, cited by the Examiner, does not describe an analysis engine that is multi-factored, analyzes on a per user basis, and uses at least one user preference. Br. 15-16. The Examiner responds that Roberts in Figure 5, item 416, and column 7, line 47-column 9, line 12 describes this limitation. Answer 8.

Roberts describes a computer 10 which processes service provider rate plan information, customer usage information, and a selection of a proposed service provider plan (*i.e.*, at least one user preference) for each user to create a report. FF 1-4 and 8. We find that this reads on the claimed multi-factor rate analyses engine module since the analysis is based on the

factors describes above and can be done on a per user basis. Further, the claimed user preference reads on the selection of a proposed service provider plan in Roberts.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claims 1 and 14 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 2 and 15

Claim 2 recites “wherein the user information further includes a threshold amount of savings that would cause the user to switch rate plans.” The Examiner cites Roberts, col. 9, ll. 49-57, which describes a client choosing to switch service providers and states that “[i]t is inherent that there is a “threshold” of the user to cause them to switch.” Answer 9. The Examiner further asserts that “[t]his switch is completed in this invention automatically based on a threshold since the user “data may be automatically retrieved from dataset (Roberts col. 9, ll. 57).” *Id.*

In response, the Appellants argue that, even if it is true that a threshold is inherent, Roberts does not disclose a threshold that is included as part of the user information. App. Br. 16.

We find that Roberts does not expressly or inherently disclose a threshold that is part of the user information. In column 9, lines 49-52, Roberts states “once report 60 is created, client 16 may choose to switch 602 service providers 17 to obtain the savings outlined in report 60.” FF 14. Roberts then describe an agent having a client fill out paperwork for the switch and suggests that some of the information for the paperwork can be automatically retrieved from the database. FF 15. However, Roberts does

not inherently or expressly describe, in this passage or others, that the user data contains the threshold. Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). “[A]lthough anticipation can be proven inherently, proof of inherent anticipation is not the same as proof of obviousness.” *Cohesive Tech. Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008). “If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not § 102 anticipation, but § 103 obviousness.” *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1577 (Fed. Cir. 1991)

Accordingly, we find that the Appellants have overcome the prima facie showing of anticipation, and we reverse the rejection of claims 2 and 15 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 3 and 16

Claim 3 recites “wherein the user information further includes information regarding a user’s usage patterns for a service over two or more periods of time.” The Appellants argue that Roberts does not disclose “looking at patterns as claimed.” Br. 17.

We note that claim 3 does not require “looking at patterns” as asserted by the Appellants. Claim 3 merely requires that the user information includes *information regarding* a user’s usage patterns. Claim 3 does not require the information to be a usage pattern only *regarding* a usage pattern.

Roberts describes the user information includes characteristics about the usage including an associated time, such as hours, minutes, and seconds. FF 4.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claims 3 and 16 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 4 and 17

Claim 4 recites “wherein prior usage information comprises prior usage information that is electronically extracted from an electronic bill payment system to avoid the need for a user to manually enter at least some prior usage information.” The Examiner cites Roberts’ column 7, lines 50-54, which describes entering phone bill data by processing scanned data using optical recognition method (FF 6), to describe this limitation. Answer 9. The Examiner states ““optical recognition methods” is “electronically extracting from an electronic bill payment system”.” Answer 9.

The Appellants argue that Roberts does not describe the prior usage information being extracted from *an electronic bill payment system*, but does not respond to the Examiner’s assertion that using optical recognition methods to extract phone bill data is electronically extracting from an electronic bill payment system. *See* Br. 17.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claims 4 and 17 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 5 and 18

Claim 5 recites “a savings module for providing personalized savings information to a user wherein the personalized savings information is generated by the analysis engine based on the user’s prior usage data and at least one of the user’s preferences.” The Appellants argue that Roberts does not describe using a user’s preference in the analysis. Br. 17-18.

As discussed above, with regards to claim 1, we find that Roberts does describe using a user’s preference (*i.e.*, a proposed service provider plan) in the analysis. FF 8.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claims 5 and 18 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 6 and 19

Claim 6 recites “wherein savings information comprises incentives or discounts available to the user based on equipment owned by the user.” The Appellants argue Roberts, including item 64 of Figure 7, does not describes this feature. Br. 18. The Examiner asserts that item 64 of Figure 7; in Roberts found at column 7, lines 59-60, and column 9, lines 25; describes discounts available to the user based on equipment owned by the user. Answer 10.

Roberts describes the user information used in the analysis as include information regarding Internet charges (FF 7) and that the report includes information regarding savings for Internet services (FF 10). We find that this reads on the limitation of claim 6. The savings information on the report includes incentive or discounts based on the user having Internet services,

which would mean that the user has Internet service equipment as well as telephone equipment.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claims 6 and 19 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 7 and 20

Claim 7 recites “wherein savings information comprises proactive savings information including user behavior change recommendation information.” The Appellants argue that Roberts does not describe proactive savings information that includes user behavior change recommendation information. Br. 18. The Examiner asserts that Roberts’ proposed usage provides proactive savings information based on behavior changes. Answer 10.

We find that the savings information on report 60 in Roberts includes proactive savings information including user behavior change recommendation information. As the Examiner asserts, Roberts report includes savings for a proposed carrier (FF 9). The Examiner further asserts that Roberts states: “Notes 65 may be included on report 60, such as text describing special conditions or features associated with a particular plan, billing increments, minimum volume requirements, ISP features, and the like.” Col. 9, ll. 25-29 and FF 11.

We find that the claimed proactive savings information, including user behavior changed recommendation information reads on Roberts’ report 60 that includes savings for a proposed carrier and conditions for the savings.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claims 7 and 20 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 8 and 21

Claim 8 recites “an external data module for storing user independent data wherein the analysis [5] engine module further analyses user independent data in generating one or more savings suggestions.” The Appellants argue that Figure 5, items 506, cited by the Examiner, does not describe the claimed external data module. Br. 19. The Examiner responds that Figure 1 clearly show the system and “the external data both collected and stored.” Answer 4.

We find that Roberts describes this limitation. Roberts describes that, “memory device 12 may be a separate data storage device operatively in communications with computer 10” which performs the analysis. *See* Roberts, col. 4, ll. 17-19 and FF 5. Database 100 contains the rate plan information (FF 3), which can be user independent.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claims 8 and 21 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 9 and 22

Claim 9 recites “the user information further including rate plan switching criteria and further comprising a switching module for automatically switching the user to a new rate plan when the rate plan switching criteria is met.” The Appellants argue that Roberts does not

describe a switching module for automatically switching the user to a new rate plan when the rate plan switching criteria is met. Br. 19-20. Similar to their argument for claim 2, the Examiner argues that Roberts inherently discloses a “rate plan switching criteria” because Roberts describes a client choosing to switch. Answer 11.

For the same reasons as discussed above with regards to claim 2, we find that Roberts does not expressly or inherently describe that the user information includes a “rate plan switching criteria” and automatically switching the user to a new rate plan when the rate plan switching criteria is met.

Accordingly, we find that the Appellants have overcome the prima facie showing of anticipation, and we sustain the rejection of claims 9 and 22 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claim 10

Claim 10 recites “a switching module for facilitating the ability for the user to switch to a new rate plan.” The Appellants argue that Roberts does not disclose a switching module. Br. 20. The Examiner cites column 7, lines 36-37, which describes an order tracking table (FF 11) as the switching module.

We find that Roberts describes the claimed switching module. Roberts describes the system creating and tracking an order to switch providers and having an order tracking database. FF 15-17. We find that the claimed switching module reads on this description of the system of Roberts.

Accordingly, we find that the Appellants have overcome the prima facie showing of anticipation, and we sustain the rejection of claim 10 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 11 and 24

Claim 11 recites “a demand aggregation module for aggregating one or more users who are willing to transfer to an identified service provider.”

The Appellants argue that Roberts does not disclose this module and that Roberts says nothing about aggregating demand. Br. 20. The Examiner cites item 604 of Figure 8 in Roberts to show this limitation. Answer 11.

We note that claim 11 does not require that the aggregated users are willing to transfer to the *same* identified service provider, only that they are willing to transfer to *an* identified service provider. Further, claim 11 expressly indicates that the aggregation may apply to only a single user. In describing step 604 of Fig. 8, Roberts states that the system associates the agent to the clients and their orders so that the agent may get credit. FF 15-18. The clients, who have placed orders to switch service providers, are aggregated by associating with an agent. We find that the claimed demand aggregation module reads on this portion of the system of Roberts.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claims 11 and 24 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claims 12 and 25

Claim 12 recites “demand aggregation module for aggregating one or more users who are willing to transfer to an identified rate plan.” The

Appellants argue that Roberts does not disclose this module and that Roberts says nothing about aggregating demand. Br. 21. The Examiner cites item 604 of Figure 8 in Roberts to show this limitation. Answer 11.

We note that claim 12 does not require that the aggregated users are willing to transfer to the *same* identified rate plan, only that they are willing to transfer to *an* identified rate plan. Further, claim 12 expressly indicates that the aggregation may apply to only a single user. In describing step 604 of Fig. 8, Roberts states that they system associates the agent to the clients and their orders so that the agent may get credit. FF 15-18. The clients, who have placed orders to switch plans, are aggregated by associating with an agent. We find that the claimed demand aggregation module reads on this portion of the system of Roberts.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claims 12 and 25 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claim 13

Claim 13 recites “means for automatically monitoring rate plans for a subscriber user” and “a delivery module for delivering alerts to a subscriber user when a better rate is available to the subscriber user.” The Appellants argue that Roberts’ description of monitoring of an order status, cited by the Examiner, is not monitoring to determine if a better plan is available or the delivery mode by which such information should be communicated. Br. 21.

First, we note that “means for automatically monitoring rate plans for a subscriber user” is a limitation in means-plus-function format. A claim limitation that includes the term “means” is presumed to be intended to

invoke means-plus-function treatment, *i.e.*, treatment under 35 U.S.C. §112, 6th paragraph. *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302 (Fed. Cir. 1999). 35 U.S.C. 112, sixth paragraph:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The Specification describes the means for automatically monitoring rate plans for a user as an analysis engine module 240. *See* Specification 34:11-15 and 35:17-22. Roberts also discloses a computer 10 that performs an analysis of rate plans. FF 2. The Appellants fail to argue that Roberts' computer 10 is not an equivalent of the analysis engine module 240.

Second, as to the limitation of a “delivery module for delivering alert to a subscriber user when a better rate is available to the subscriber user,” we find that, given the broadest reasonable interpretation, the claimed delivery module reads on the computer 10's delivery of a report, which can be considered an alert. FF 9. Reports are sent when a better rate is available to the user. *Id.*

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claim 13 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claim 26

Though, the Appellants argue claimed 13 and 26 together, we will discuss claim 26 separately since it is broader in scope. Claim 26 recites a

step of “enabling the user to specify one or more modes of delivery.” The Appellants argue that Roberts does not describe this limitation. Br. 21-22.

We find that this limitation reads on Roberts’ descriptions of choice of media for creating the report (FF 13) and/or a choice of including label information on the report (FF 12). Both allow the user to specify a mode of delivery of the report.

Accordingly, we find that the Appellants have not overcome the prima facie showing of anticipation, and we sustain the rejection of claim 26 under 35 U.S.C. § 102(e) as anticipated by Roberts.

Claim 23

The Appellants present no argument directed to claim 23. Therefore, we also shall sustain the standing 35 U.S.C. § 102(e) rejection of dependent claim 23 as being anticipated by Roberts since the Appellants have not challenged such with any reasonable specificity, thereby allowing claim 23 to stand or fall with parent claim 14 (see *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987)).

CONCLUSIONS OF LAW

We conclude that the Appellants have not overcome the prima facie showing of anticipation as to the rejection of claims 1, 3-8, 10-14, 16-21, and 23-26 under 35 U.S.C. § 102(e) as anticipated by Roberts.

We conclude that the Appellants have overcome the prima facie showing of anticipation as to the rejection of claims 2, 9, 15, and 22 under 35 U.S.C. § 102(e) as anticipated by Roberts.

DECISION

The decision of the Examiner to reject claims 1, 3-8, 10-14, 16-21, and 23-26 is affirmed.

The decision of the Examiner to reject claims 2, 9, 15 and 22 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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